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On 12-23-03

TOWNSEND and TOWNSEND and CREW LLP

By: Karen Karlin



PATENT

Attorney Docket no. 02307K-141313US  
Client Ref. no. 96-540-5

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

*In re* application of:

Sawyers *et al.*

Application No.: 10/062,684

Filed: January 30, 2002

For: METHODS OF SIMULATING  
HUMAN PROSTATE CANCER  
PROGRESSION

Customer No.: 20350

Confirmation No. 4751

Examiner: Thai-An N. Ton

Group Art Unit: 1632

PETITION UNDER 37 CFR §1.47(a)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR §1.47(a), Applicants hereby petition for filing of the above-identified patent application when a joint inventor refuses to sign or cannot be found or reached after diligent effort. Proof of the pertinent facts is submitted herein with the petition, to properly establish that a diligent effort has been made to obtain the signature of joint inventor Dr. Karen A. Klein. Specifically, Applicants are submitting the following items:

Exhibit A: a photocopy of the letter (dated September 19, 2003) accompanying a substitute Combined Declaration and Power of Attorney along with a copy of the subject patent

application and original Combined Declaration Power of Attorney filed in this application that were mailed to Dr. Klein at her last known work address.

Exhibit B: a photocopy of a letter (dated November 5, 2003) accompanying a copy of the substitute Combined Declaration and Power of Attorney that were sent via priority FedEx to her last known home address; copy of FedEx proof of delivery.

Exhibit C: a photocopy of a letter (dated November 13, 2003) accompanying another copy of the substitute Combined Declaration and Power of Attorney that were sent via certified mail to her last known home address; copy of certified mail return receipt postcard.

Exhibit D: a photocopy of a letter (dated November 18, 2003) accompanying a copy of the original Declaration and patent application, along with a pre-paid FedEx envelope for returning the signed substitute Combined Declaration and Power of Attorney.

The Examiner deemed the original Declaration filed in this application as defective and required filing of a compliant Declaration. All of the inventors (Drs. Sawyers, Witte, Reiters, and Klein) signed the combined Declaration and Power of Attorney as originally filed in the application.

A substitute Combined Declaration and Power of Attorney (with copies of the original document and patent application) were sent via first class mail to the inventors at the work addresses at the University of California. Signed substitute Declaration and Power of Attorney documents were received from Drs. Sawyers, Witte, and Reiter. Dr. Sawyers informed the undersigned agent that Dr. Klein no longer worked in his laboratory and he did not have any further information about where she could be contacted.

The last known address of Dr. Klein is 174 Denslow Avenue, Los Angeles, CA 90049. Two attempts were made by Applicant's agents to reach Dr. Klein to obtain her signature on the substitute Declaration at this address. The deliveries to her home address were via Federal Express (see Exhibit B) and via Certified Mail (see Exhibit C), as shown by the evidence submitted herewith. These deliveries were signed for by Sean Turner.

No phone number listing was identified in the Los Angeles phone directory, however, the application owner found a last known home phone number in their files. On November 18, 2003, Applicants' agent spoke to Dr. Klein on the phone. She confirmed that her home address of record was current and that the documents had been received. Subsequent to the conversation, Dr. Klein was sent a copy of the application and the original Declaration/Oath, along with a pre-paid FedEx envelope (Exhibit D). No response has been received.

In view of the foregoing, we petition to proceed without Dr. Klein's signature. The other joint inventors, Drs. Sawyers, Witte, and Reiter, have executed the substitute Combined Declaration and Power of Attorney for the application (enclosed). Because Dr. Klein has not signed the documents after diligent effort, Applicants respectfully request that the above-identified application be filed on behalf of Drs. Sawyers, Witte, and Reiter and the non-signing joint inventor, Dr. Klein, in accordance with 37 CFR §1.47(a).

Please charge fee for filing this petition to our Deposit Account no. 20-1430 in accordance with the accompanying Fee Transmittal PTO/SB/17 submitted in duplicate

Respectfully submitted,



Chuan Gao  
Reg. No. 54,111

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
JML:jml  
60106324 v1

# MANDEL & ADRIANO

INTELLECTUAL PROPERTY ATTORNEYS



SARALYNN MANDEL  
SARAH B. ADRIANO\*  
55 S. LAKE AVENUE, SUITE 710  
PASADENA, CA 91101  
PHONE (626) 395-7801  
FAX (626) 395-0694  
\*Admitted in New York Only

September 19, 2003

**U.S. Mail – Return Receipt Requested**

Dr. Charles L. Sawyers  
11-934 Fator Building  
UCLA-Hematology/Oncology  
10833 Le Conte Avenue  
Los Angeles, California 90095

Dr. Karen A. Klein  
11-934 Fator Building  
UCLA-Hematology  
10833 Le Conte Avenue  
Los Angeles, California 90095

Dr. Owen N. Witte  
HHMI/UCLA  
5-720 MRL  
675 Charles E. Young Drive South  
Box 951622  
Los Angeles, California 90095-1662

Dr. Robert E. Reiter  
UCLA Urology Department  
Box 951738  
650 Circle Drive South  
Room #66-134  
Los Angeles California 90095-1738

Re: Charles L. Sawyers et al., entitled "METHODS OF SIMULATING HUMAN PROSTATE CANCER PROGRESSION," U.S. Serial No. 10/062,684 filed January 30, 2002, which is a continuation of U.S. Serial No. 09/567,202 filed May 8, 2000, now issued U.S. Patent No. 6,365,797, issued on April 2, 2002, which is a divisional of U.S. Serial No. 08/951,143 filed October 15, 1997, now issued U.S. Patent No. 6,107,540, issued on August 22, 2000, which was a CIP of U.S. Serial No. 08/732,676 filed October 15, 1996, now abandoned; Your Ref. 96-540-5 (Sawyers); M&A Ref. 30435.53USD3

Dear Drs. Sawyers, Klein, Witte and Reiter:

I enclose a copy of the above-referenced U.S. Patent application and an original Combined Declaration and Power of Attorney. Please review the enclosed application then sign and date the Combined Declaration and Power of Attorney where indicated, in black ink. Please return the Combined Declaration and Power of Attorney to us by facsimile, and the originals by mail to the above address by **October 18, 2003**.

Failure to return the executed documents by the **October 18, 2003** date will be viewed as a refusal to sign.

Dr. Charles L. Sawyers  
Dr. Karen A. Klein  
Dr. Owen N. Witte  
Dr. Robert E. Reiter  
September 19, 2003  
Page 2

If you have any questions or comments, please contact us. Meanwhile, thank you for your cooperation.

Sincerely,



Richelle Ann Domingo  
Legal Assistant

/rapd

Enclosure

cc: Lorelei de Larena, Esq. (w/ encl.)  
Ms. Linda Stevenson (w/ encl.)  
Timothy Lithgow, M.D., J.D. (w/ encl.)  
Sarah B. Adriano, Esq. (w/o encl.)  
Stephanie Hsieh, Esq. (w/o encl.)

C:\Documents and Settings\rdomingo\My Documents\30435\53usd3\corres\ltr inventors re-execute dec.doc

TOWNSEND  
and  
TOWNSEND  
and  
CREW



Direct: (415) 273-4758  
klb@townsend.com

November 5, 2003

**Via FedEx**

Dr. Karen A. Klein  
174 Denslow Avenue  
Los Angeles, CA 90049

Re: U.S. Patent Applications Serial Nos. 10/062,684, 10/062,738 and 10/062,925  
filed January 30, 2002 for  
METHODS OF SIMULATING HUMAN PROSTATE CANCER PROGRESSION;  
MICE MODELS OF HUMAN PROSTATE CANCER PROGRESSION; and  
METHODS OF ASSESSING THE EFFECT OF A GENE OF INTEREST ON HUMAN  
PROSTATE CANCER PROGRESSION  
Inventors: Charles L. Sawyers, Karen A. Klein, Owen N. Witte  
and Robert E. Reiter  
UC Case no. 1996-540-5, -8 and -7  
Our file no. 02307O-1413-13US, -16US and -15 US

Dear Dr. Klein:

Responsibility for prosecution of the above patent applications has recently been transferred by the assignee, the Regents of the University of California, to our firm from the Mandel & Adriano firm.

We note that revised Declarations have been required by the examiner, but the forms for your signature were addressed to your old work address at the UCLA Hematology lab. We have received signed Declarations back from your co-inventors and would like to file all documents with the U.S. Patent and Trademark Office by **November 16, 2003**. Please sign and return your three Combined Declaration and Power of Attorney forms to us by that date.

If you have any questions, please telephone me. Thank you.

Very truly yours,

A handwritten signature in black ink, appearing to read "Jean M. Lockyer".

Jean M. Lockyer, Ph.D.  
Patent Agent

JML/mcd  
Enclosure

60075688 v1



FedEx Express  
Customer Support Trace  
3875 Airways Boulevard  
Module H, 4th Floor  
Memphis, TN 38116

U.S. Mail: PO Box 727  
Memphis, TN 38194-4643

Telephone: 901-369-3600

11/10/2003

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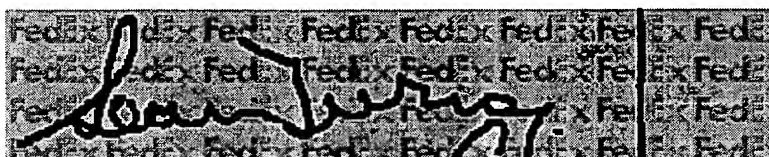
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**Signed For By:** K.KLEIN



**Delivery Location:** 174 DENSLOW AVE.

**Delivery Date:** November 6, 2003

**Delivery Time:** 1015

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**Tracking No:** 790953528160

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**Recipient:**  
KAREN KLEIN

174 DENSLOW AVE.  
LOS ANGELES, CA 90049  
US

**Shipper:**  
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**Shipment Reference Information:**

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*Handwritten notes:*  
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K. Klein

TOWNSEND  
and  
TOWNSEND  
and  
CREW



Direct: (415) 273-4758  
klb@townsend.com

November 13, 2003

**Certified Mail**  
**Return Receipt Requested**

Dr. Karen A. Klein  
174 Denslow Avenue  
Los Angeles, CA 90049

Re: U.S. Patent Applications Serial Nos. 10/062,684, 10/062,738 and 10/062,925  
filed January 30, 2002 for  
METHODS OF SIMULATING HUMAN PROSTATE CANCER PROGRESSION;  
MICE MODELS OF HUMAN PROSTATE CANCER PROGRESSION; and  
METHODS OF ASSESSING THE EFFECT OF A GENE OF INTEREST ON HUMAN  
PROSTATE CANCER PROGRESSION  
Inventors: Charles L. Sawyers, Karen A. Klein, Owen N. Witte  
and Robert E. Reiter  
UC Case no. 1996-540-5, -8 and -7  
Our file no. 02307O-1413-13US, -16US and -15 US

Dear Dr. Klein:

Enclosed are copies of our letter and enclosures sent to you via FedEx on November 5th. It is not clear that you received this package, as another individual's signature was on the FedEx form.

If you have any questions, please telephone me. We would appreciate it if you could return these by the next due date, **November 25th**. Thank you.

Very truly yours,

A handwritten signature in black ink, appearing to read "Jean M. Lockyer".

Jean M. Lockyer, Ph.D.  
Patent Agent

JML/mcd  
Enclosures

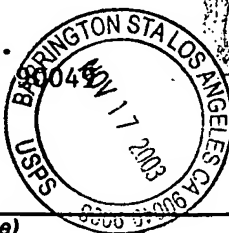
60082339 v1





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3. Article Addressed to: Karen Klein 174 Denslow Ave. Los Angeles, CA 90045		4a. Article Number P 185 076 810	
5. Received By: (Print Name) Sean Turner		4b. Service Type <input type="checkbox"/> Registered <input checked="" type="checkbox"/> Certified <input type="checkbox"/> Express Mail <input type="checkbox"/> Insured <input type="checkbox"/> Return Receipt for Merchandise <input type="checkbox"/> COD	
		7. Date of Delivery 11/15/03	
6. Signature: (Addressee or Agent) <input checked="" type="checkbox"/> Sean Turner		8. Addressee's Address (Only if requested and fee is paid)	

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TOWNSEND  
and  
TOWNSEND  
and  
CREW



San Francisco, CA

November 18, 2003

FedEx

Dr. Karen A. Klein  
174 Denslow Avenue  
Los Angeles, CA 90049

Re: U.S. Patent Applications Serial Nos. 10/062,684, 10/062,738 and 10/062,925  
filed January 30, 2002 for  
METHODS OF SIMULATING HUMAN PROSTATE CANCER PROGRESSION;  
MICE MODELS OF HUMAN PROSTATE CANCER PROGRESSION; and  
METHODS OF ASSESSING THE EFFECT OF A GENE OF INTEREST ON HUMAN  
PROSTATE CANCER PROGRESSION  
Inventors: Charles L. Sawyers, Karen A. Klein, Owen N. Witte  
and Robert E. Reiter  
UC Case no. 1996-540-5, -8 and -7  
Our file no. 02307K-1413-13US, -16US and -15 US

Dear Dr. Klein:

The three above applications are children of a parent application. Enclosed is a copy of that parent and the original Declaration that you signed at the time of filing. As I mentioned in our telephone conversation, the examiner has required us to submit a substitute Declaration in each of the children applications to correct a typographical error on the first page of the original Declaration.

Enclosed is pre-paid FedEx envelope for your convenience in returning your signed Declarations to us. Thank you.

Very truly yours,

A handwritten signature in black ink, appearing to read "Jean M. Lockyer".

Jean M. Lockyer, Ph.D.  
Patent Agent

JML/mcd  
Enclosures

60085391 v1

From: Malinda Dagit (415)576-0200  
Townsend and Townsend and Crew LLP  
Two Embarcadero Center  
8th Floor  
San Francisco, CA, 94111

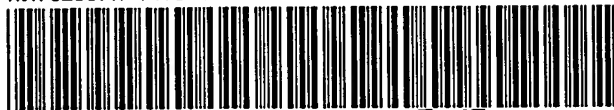
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**FedEx.****To: Karen Klein (415)273-4373****174 Denslow Ave.****Los Angeles, CA, 90049**

Ref: 02307K-1413-13US

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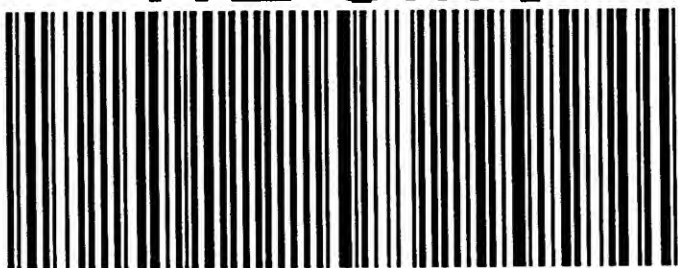
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